

## REMARKS

Claim 2 is amended herein. No new matter is being presented, and approval and entry are respectfully requested. Claim 13, previously withdrawn by the Examiner, is cancelled without prejudice or disclaimer.

Claims 2-4 are pending. Reconsideration is requested.

### ACTION IS INCOMPLETE AND FINALITY IS PREMATURE

As set forth in MPEP §707.07(f) entitled Answer All Material Traversed:

an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Applicants respectfully submit that the current office action is incomplete since the Examiner has not responded, at all, to many of Applicant's arguments traversing the rejections presented in the Amendment filed November 18, 2005 (previous Amendment). As set forth in MPEP § 706.07(d):

(i)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

In traversing the rejection of claim 2 under 35 U.S.C. §102(e) as anticipated by Revashetti (U.S.P. 6,370,578) the Applicants argued that the Examiner has not provided any support for the inherency that analysis of a current configuration teaches "identification" of a client computer, let alone identifying "first user terminals that have selected a first product as a candidate for purchase."

Applicants pointed out the errors in the Examiner's action and demanded support or an affidavit in accordance with M.P.E.P. § 2144.03(A) and 37 C.F.R. § 1.104(d)(2)

The Examiner has not provided either and has not responded to the Applicants arguments in the previous Amendment that the Examiner's statement of inherency is not supported.

in addition in traversing the rejection of claims 2-4 under 35 U.S.C. §103(a) as being unpatentable over Revashetti in view of Welsh et al. (U.S.P. 6,757,691), Applicants argued there is no reasonable chance of success to modify a system taught by Revashetti that teaches marketing based on a current computer configuration with a system taught by Welsh of marketing of based on a predicted behavior. The Examiner has also not responded to this Applicants arguments regarding modification of Revashetti in view of Welsh.

### Summary

Applicants submit that the current Action is incomplete and the finality of the current Office Action is premature. Accordingly, Applicants request that a new Office Action including a

complete response should be mailed and with the response date reset.

#### **ENTRY OF AMENDMENT UNDER 37 CFR §1.116**

Applicant requests entry of this Rule 116 Response because it is believed that the amendment of claim 2 puts this application into condition for allowance and should not entail any further search by the Examiner since no new issues are being raised.

Claim 2 is amended herein to clarify a information presentation includes "parameter storage means for storing said search parameters for the selected product or service as a candidate for purchase, selected product or service information, and user identification information that identifies said user terminal." No new matter is being presented, and approval and entry are respectfully requested.

#### **TRAVERSE OF REJECTIONS**

I. On pages 2-3 of the Office Action, the Examiner rejects independent claim 2 under 35 U.S.C. §103(a) as being unpatentable over Revashetti in view of Havens (U.S.P. 5,752,242).

Claim 2, as amended, recites an information presentation device in which a user terminal on a network that retrieves products or services that match search parameters designated by the user including "accepting means for accepting a selection of a product or service that is included in said products or services that were retrieved based on the search parameters designated by the user; and parameter storage means for storing said search parameters for the selected product or service as a candidate for purchase, selected product or service information, and user identification information that identifies said user terminal."

That is, according to aspects of the present invention, each users' reason for selecting a product/service and the background of the users' desires can be learned by correlating a search condition used for searching products and services selected as purchase candidates, a selected product/service and a user identification information.

Applicants submit that these features are not taught by the cited art alone or in combination.

Revashetti merely teaches that all the users are correlated with the same keyword. Therefore, the effect of the present invention cannot be achieved by Revashetti even in an *agurendo* combination with Havens.

In support of the rejection, the Examiner repeats his contention that Revashetti teaches search parameters are stored together "with user identification information that identifies said user terminal" since Revashetti teaches:

analysis is particular to a given computer. . . and hence inherently must include identification of the client computer 208).

(Action at page 3).

As discussed above in the section submitting that the current Action is incomplete, the Examiner has not provided support for the inherency.

Revashetti, alone or in combination, does not teach a storing of "identification information that identifies said user terminal." Rather, Revashetti merely teaches (col. 6, lines 60-62) a method to "analyze the current configuration of the client computer."

Further, there is no discussion in Haven, nor has the Examiner provided a citation to such, to teach storing search parameters with "identification information that identifies said user terminal."

Rather, Havens merely teaches setting a narrowing-down condition for a search result for each user and that when search condition is inputted, a further result is extracted using the narrowing-down condition for each user from the search result obtained based on the search condition.

Therefore, Havens does not teach features according to an aspect of the present invention in which search information that a user designates for searching a product/service and a selected product/service are correlated and stored.

Since features recited by claim 2 are not taught by the cited art, alone or in combination the rejection should be withdrawn.

II. On pages 4-5 of the Office Action, the Examiner rejects dependent claims 3-4 under 35 U.S.C. §103(a) as being unpatentable over Revashetti in view of Havens in further view of Welsh.

Dependent claims 3-4 recite an information presentation device including "user reference request accepting means for accepting user reference requests from first group of computer terminals on said network; and parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals, and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal."

The Examiner contends there is motivation to modify Revashetti and Havens with Welsh for "the ability to categorize(d) groups of users or people who like a certain product for ease in mass marketing." (Action at page 5).

Applicants submit there is no motivation or reasonable chance of success to modify as the Examiner contends since there is no reasonable chance of success to modify a system taught by Revashetti that teaches marketing based on a current computer configuration with a system taught by Welsh of marketing of based on a predicted behavior.

Since there is no motivation to combine the art the rejection of claims 3-4 should be withdrawn

#### Summary

Since features recited by the claims are not taught by the cited art alone or in combination, there is no reasonable chance of success to combine the art in a manner as the Examiner suggests, and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 2-4 allowed.

#### CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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